REMARKS

A four-month Request for Extension of Time is being concurrently filed for responding to the Notice of Appeal dated March 4, 2004 in the above-identified application. Applicant's response to the Notice of Appeal is being concurrently filed in a Request for Continued Examination (RCE) with an Amendment and appropriate fees.

An Information Disclosure Statement is being concurrently filed with the response.

Applicant maintains that Shimizu (assuming, arguendo, it can even be properly applied under 35 U.S.C. 102(e)), either alone or in combination with Hubbell, fails to teach automatically selecting a plurality of media elements in response to a request for media programming, and automatically selecting a temporal organization for selected media elements, such temporal organization not being dictated by the selected information, all as recited in Applicant's independent claims. Furthermore, it is clear that Hubbell does not teach automatically selecting media elements.

In addition, the teaching of Shimizu is not equivalent, as alleged by the Examiner, to Applicant's selecting a plurality of media elements, either manually or automatically. Applicant is not simply automating a previously known manual process, but rather provides a new, unique and unobvious media system with enhanced capabilities.

The Examiner also postulates that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. However, this overlooks the requirement that the combination must be suggested within

PAGE 10/22 * RCVD AT 10/18/2004 1:32:37 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-2/4 * DNIS:7465621 * CSID:310 824 9696 * DURATION (mm-ss):06-58

at least one of the references used in the combination, and neither Shimizu nor Hubbell embody such a teaching. Moreover, Applicant maintains that even the proposed combination is not conceptually, functionally and structurally the same as Applicant's invention, even ignoring the incompatibility of the references.

The rejection of Applicant's claims 1-5, 8, 9, 11-15, 18, 19, 21-31, 36-37, 47, 50, 57-598, 67, 79 and 80-83 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 5,861,880 issued to Takeshi Shimizu et al. ("Shimizu") is respectfully traversed for the reasons previously expressed in this and prior letters and amendments. The Examiner relies on Shimizu to teach automatically selecting a plurality of said media elements in response to a request for media programming, and automatically selecting a temporal organization for the selected media elements. However, Shimizu does not teach, show, suggest or describe a media system for automatically selecting a plurality of media elements in response to a request for media programming, and then automatically selecting a temporal organization for the selected media elements, the temporal organization not being dictated by the selected information. Instead, Shimizu merely teaches only manually selecting media elements. Moreover, Shimizu does not teach any automatic selection or assembly functions whatsoever.

The Examiner also relies on Shimizu to teach a method for verifying viewing and comprehension of a media program. However, Shimizu does not teach, suggest or describe any such method and, indeed, Shimizu does not even mention verification that a media program was either viewed or comprehended.

PAGE 11/22 * RCVD AT 10/18/2004 1:32:37 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-2/4 * DNIS:7465621 * CSID:310 824 9696 * DURATION (mm-ss):06-58

Reconsideration is similarly requested for the rejection of claims 6, 7, 10,16, 17, 20, 32-35, 28-46, 48, 49, 51-56, 60-66 and 68-71 under 35 U.S.C. 103(a) as being unpatentable over Shimizu and in view of U.S. Patent Number 5,966,121 issued to John Hubbell et al. ("Hubbell").

In addition to Applicant's previously argued distinctions, the Examiner concedes in the last office action that Shimizu "does not explicitly teach control tags contains transition information and a luminance range for a portion of said media clip."

Hence, the present invention is not unpatentable over Shimizu in view of Hubbell because neither Shimizu nor Hubbell, nor the combination of both (if even appropriate), teaches automatically selecting a plurality of said media elements in response to a request for media programming, and automatically selecting a temporal organization for said selected media elements, said temporal organization not being dictated by said selected information. As previously indicated, Shimizu teaches only manually selecting media elements. Shimizu does not teach any automatic selection or assembly functions. Hubbell does not teach automatically selecting media elements or automatically selecting a temporal organization not dictated by the selected information. Hubbell merely teaches a pre-defined content that is delivered according to a fixed temporal arrangement. Additionally, Hubbell teaches that, in the only instances in which a temporal organization might not be fixed (i.e., user interactions introducing branches in the programming), the media element is selected manually by a user rather than automatically. Further, any branch automatically taken by the program is pre-determined and the media elements

PAGE 12/22 * RCVD AT 10/18/2004 1:32:37 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-2/4 * DNIS:7465621 * CSID:310 824 9696 * DURATION (mm-ss):06-58

surrounding the branch have a temporal organization dictated by the selected information. The superficial conglomeration of references by the Examiner is only in light of Applicant's own teachings and is not taught by the prior art.

The Examiner also relies on Shimizu and Hubbell to teach a method for verifying viewing and comprehension of a media program. However, neither Shimizu nor Hubbell teaches, shows, suggests or describes a method for verifying viewing and comprehension of a media program. Neither Shimizu nor Hubbell even mentions verification that a media program was either viewed or comprehended.

Moreover, there is no suggestion in any of the prior art to combine Hubbell with Shimizu to permit access to a video editing format and to efficient modification of the data signal portion of a multimedia bit-stream.

Once Applicant has taught his new and improved media system and its new and unexpected results, redesign may, by hindsight, seem to be obvious to one having ordinary skills in the art. However, when viewed as of the time Applicant's invention was made, and without the benefit of Applicant's own disclosure, there is nothing in the art of record which realistically suggests Applicant's invention.

For at least the foregoing reasons, Applicant submits that the cited references do not teach, show, suggest or describe the present invention and that Claims 1-71 and 79-83 are patentably distinct from the cited prior art. Therefore, Applicant submits that all of these claims are allowable.

PAGE 13/22 * RCVD AT 10/18/2004 1:32:37 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-2/4 * DNIS:7465621 * CSID:310 824 9696 * DURATION (mm-ss):06-58

If the Examiner persists in his rejection of Applicant's claims, it is contemplated that these issues may be further resolved by interview and demonstration of Applicant's invention at the U.S. Patent and Trademark Office.

CONCLUSION

It is believed that this case is now in condition for allowance, and an early Notice of Allowance to this effect is earnestly solicited. If the Examiner wishes to discuss this matter, please contact Applicant's attorney at 310/824-5555, Ext. 560.

Respectfully submitted,

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PAGE 14/22 * RCVD AT 10/18/2004 1:32:37 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-2/4 * DNIS:7465621 * CSID:310 824 9696 * DURATION (mm-ss):06-58